

### REMARKS

Claims remaining in the present patent application are Claims 16-35. Claim 16 is amended herein. Applicants respectfully assert that no new material is introduced as a result of the amendments herein. Applicants respectfully request consideration of the above captioned patent application in light of the remarks presented herein.

#### ***Rejections Under 35 U.S.C. §101***

At paragraph 4 of the Office Action, the Examiner rejected claims 16-19, 22, and 23 as being directed to non-statutory subject matter. Specifically, the Examiner noted that claim 16 could be interpreted as a series of mental and/or manual steps. Applicant submits that a mental step or human step test is an improper test for determining whether statutory subject matter exists. *See*, Annex III of the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, October 26, 2005. The rejection of claims 16-19, 22, and 23 is therefore traversed.

#### ***Rejections Under 35 U.S.C. §112, second paragraph***

At paragraph 6 of the Office Action, the Examiner rejected claims 2, 5, 10, and 21 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. By the amendment above, claims 2, 5, 10, and 21 have been canceled. The rejection of claims 2, 5, 10, and 21 is therefore rendered moot.

#### ***Rejections Under 35 U.S.C. §103***

At paragraphs 7-9 of the Office Action, the Examiner rejected claims 1-23 as being unpatentable over Microsoft Word 2000 ("MS Word") in view of U.S. Patent No. 6,771,801 to Fisher et al. ("Fisher").

By the amendment above, claims 1-15 have been canceled. The rejection of claims 1-15 is therefore rendered moot.

Regarding claim 16, the Examiner notes the following:

MS Word teaches the use of templates which were used for generating user specified documents such as a photo album page (p. 4). MS Word teaches that templates can be created from existing documents, such as a user created table containing graphic images.

In this excerpt, the Examiner describes a transformation process wherein a first input type is used to create a second output type. For example, a template can be used to create a document, and conversely, a document can be used to create a template. This transformation process is therefore focused on distinct input and output types. The Examiner has provided no basis to suggest that the output would be viewed along with the input for comparison purposes.

In Applicant's claim 16, the second graphical image page is viewed along with the first graphical image page for comparison purposes. This claim feature enables each of the first and second graphical image pages to be independently modified. For example, the user could separately modify a background on the first graphical image page, and separately modify a picture border on the second graphical image page. Viewing the a first candidate image page along with a second candidate image page enables the user to determine which of the two different candidate image pages should be selected.

This comparison process is distinct from the MS Word teachings produced by the Examiner. As noted above, the template teachings are focused on two distinct input/output types and are not intended to be compared with each other. The MS Word Split command also does not teach Applicant's claimed comparison display. While the MS Word Split command does produce a second window in a side-by-side display, the second window is another view of the same document. Any change in a first document window will then also be reflected in the second document window. Thus, the MS Word Split command cannot independently modify one of the document windows.

For at least these reasons, Applicant submits that the teachings of MS Word do not show Applicant's displaying a second graphical image page along with a first graphical image page for

comparison of the first graphical image page and the second graphical image page, each of the first and second graphical image pages capable of being independently modified.


Fisher also does not correct the deficiencies of MS Word. Fisher was introduced for the teaching of a method of generating a photo album page using a template and images supplied by a user. The Examiner has made no assertion that Fisher teaches a display that enables comparison of photo album pages and independent modification of those photo album pages. Applicant therefore submits that the Examiner has not produced a *prima facie* case of obviousness in producing a combination of references that teaches every feature of Claim 16. The rejection of claim 16, as well as its dependent claims, is therefore traversed.

### **Conclusion**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections, and that they be withdrawn. The Examiner is invited to telephone the undersigned representative if an interview might be useful for any reason.

Respectfully submitted,

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